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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,364	11/15/2001	Terry Allen-Rouman	020375-002730US	2552

20350 7590 02/07/2005

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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,364

Applicant(s)

ALLEN-ROUMAN ET AL.

Examiner

Debra F. Charles

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6pages.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 7, 9-13, and 15-20 are rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a “useful, concrete, tangible result” (*In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir.

1994) and *State Street vs. Financial Signature Group Inc.*, 47

USPQ2d 1596' 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, "in the technological arts" was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art,

environment, or machine, the claim is not statutory. *Ex parte Bowman*
61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2, 3, 4, 5, 6,8, 10,13, and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg et al.(USPUB 2002/0169712 A1) and Manasse(US PAT 5802497A).

Re claims 1 and 9: Ginzboorg et al. disclose a method for transferring funds between a payor and a payee in an online transaction for incremental payments(Abstract, page 2 para 0033-0034, page 3, para 0050-0051).

Ginzboorg et al. disclose(s) the claimed invention except

receiving information from the payor for debiting a bank account associated with the payor;

transmitting to the payee authorization to request debits from the payor,

wherein a total of all debit requests does not exceed an amount for the online transaction;

receiving a first request from the payee to debit the payor a first portion of the amount;

initiating a first debit from the bank account for the first portion of the amount;

receiving a second request from the payee to debit the payor a second portion of the amount; and

initiating a second debit from the bank account for the second portion of the amount.

However, in Abstract, col. 2, lines 1-30 thereof, Manasse disclose(s) the back and forth communications and payment distribution of first payment and then second payment after getting a first and then a second request. **It would be obvious to one of ordinary skill in the art to modify the invention** of Ginzboorg et al. based on the teachings of Manasse. The motivation to combine these references is to effectively and efficiently make transactions back and forth based on the first request and second request.

Ginzboorg et al. disclose(s) the claimed invention except for the technology back and forth communication. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the back and forth communication using technology since it has been held that broadly providing a mechanical

or automatic means to replace manual activity that has accomplished that same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re claims 2 and 10: Ginzboorg et al. disclose(s) comprising a step of checking that a sum of the first debit and the second debit does not exceed the amount before performing the second-listed initiating step(page 6, para 0097, 0098).

Re claim 3: Ginzboorg et al. disclose(s) wherein the first-listed receiving step comprises steps of:

storing information on a plurality of accounts associated with the payor; and

receiving selection of the bank account from the plurality of accounts(page 8, para 0125, page 9, para 0128).

Re claim 4: Ginzboorg et al. disclose(s) the claimed invention except

further comprising steps of:

initiating a first credit to a payee account that corresponds to the first portion of the amount; and

initiating a second credit to a payee account that corresponds to the second portion of the amount.

However, in Abstract, col. 2, lines 1-30 thereof, Manasse disclose(s) the back and forth communications and payment distribution of first payment and then second payment after getting a first and then a second request. **It would be obvious to one of ordinary skill in the art to modify the invention** of Ginzboorg et al. based on the teachings of Manasse. The motivation to combine these references is to effectively and efficiently make transactions back and forth based on the first request and second request.

Ginzboorg et al. disclose(s) the claimed invention except for the technology back and forth communication. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the back and forth communication using

technology since it has been held that broadly providing a mechanical or automatic means to replace manual activity that has accomplished that same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re claim 5: Ginzboorg et al. disclose(s) the claimed invention except for the first credit is less than the first debit, and the second credit is less than the second debit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automate the back and forth communication using technology since it has been held that broadly providing a mechanical or automatic means to replace manual activity that has accomplished that same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re claim 6: Ginzboorg et al. disclose(s) comprising a step of receiving information from the payee for crediting a payee account(para. 0034-0040).

Re claim 13: Ginzboorg et al. disclose the invention except comprising a step of receiving information from the second party for crediting a second account of the second party.

However, in Abstract, col. 2, lines 1-30 thereof, Manasse disclose(s) the back and forth communications and payment distribution of first payment and then second payment after getting a first and then a second request. **It would be obvious to one of ordinary skill in the art to modify the invention** of Ginzboorg et al. based on the teachings of Manasse. The motivation to combine these references is to effectively and efficiently make transactions back and forth based on the first request and second request.

Re claims 8 and 14: Ginzboorg et al. disclose a computer-readable medium having computer-executable instructions for performing the computer-implementable method for transferring funds between the payor and the payee in the online transaction of claim 1 (page 9, 0128).

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg et al. and Manasse as applied to claim 1 above, and further in view of Tateisi et al.(U.S.PAT. 4678895A).

Re claim 7: Ginzboorg et al. and Manasse disclose(s) the claimed invention except comprising a step of receiving an indication from the payor of which of a plurality of accounts to use as the bank account for the online transaction. However, in col. 4, line 60-col. 5, line 5, claim 5 thereof, Tateisi et al. disclose(s) selecting a bank account among various bank accounts. It would be obvious to one of ordinary skill in the art to modify the invention of Ginzboorg et al. and Manasse based on the teachings of Tateisi et al. The motivation to combine these references is to effectively and efficiently enhance the availability of funds by selecting from a plurality of bank accounts.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg et al. and Manesse as applied to claim 9 above, and further in view of Rosen(U.S. PAT. 5453601A).

Re claim 11. Ginzboorg et al. and Manesse disclose(s) the claimed invention except further comprising a step of initiating a plurality of credits to a second account of the second party wherein the plurality of credits correspond to the plurality of debits. However, in col. 60, lines 20-45 thereof, Rosen disclose(s) multiple funds transfers esp. credits out of the bank. It would be obvious to one of ordinary skill in the art to modify the invention of Ginzboorg et al. and Manesse based on the teachings of Rosen. The motivation to combine these references is to effectively and efficiently move funds from point to point.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginzboorg et al., Manesse and Rosen as applied to claim 11 above, and further in view of Deep (U.S.PAT. 6393412B1).

Re claim 12: Ginzboorg et al., Manesse and Rosen disclose(s) the claimed invention wherein each of the plurality of credits is less than its corresponding debit by a fee. However, in col. 7, lines 60-65, claim 5, thereof Deep discloses reducing the credit by a fee. It would be obvious to one of ordinary skill in the art to modify the invention of Ginzboorg et al., Manesse and Rosen based on the teachings of Deep. The motivation to combine these references is to effectively and efficiently move funds from point to point.

7. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al.(US.PAT. 5649116A) and Ganesan et al.(U.S.PUB 2002/0097465 A1).

Re claim 15: McCoy et al. disclose a method for transferring funds between a customer and a merchant with a funds transfer system, the method comprising steps of:

receiving authorization to request debits of a bank account of the customer(Abstract, col. 3, lines 35-67), wherein:

the authorization resulted from interaction between the customer and the funds transfer system(col. 1, lines 15-40);

sending a plurality of request from the merchant to the funds transfer system to debit the bank account; and receiving from the automated clearinghouse (ACH) network a plurality of credits corresponding to the plurality of requests(col. 60-67).

McCoy et al. disclose(s) the claimed invention except a total of all debit requests does not exceed an amount. However, in page 1, para 0010, Ganesan et al. disclose(s) debit requests that do not exceed the amount. It would be obvious to one of ordinary skill in the art to modify the invention of McCoy et al. based on the teachings of Ganesan et al. The motivation to combine these references is to effectively and efficiently facilitate funds transfer.

Re claim 20: McCoy et al. disclose a computer-readable medium having computer-executable instructions for performing the computer-implementable

method for transferring funds between the customer and the merchant with the funds transfer system of claim 15(Col. 3, lines 35-65).

8. Claims 16, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al. and Ganesan et al. as applied to claim 15 above, and further in view of Kight et al.(U.S.PAT. 5383113A)

Re claims 16, 17 and 19. McCoy et al. and Ganesan et al. disclose(s) the claimed invention except comprising a step of checking that a sum of the plurality of requests does not exceed the amount before receiving any credit from the ACH network. And step of initiating a plurality of credits to an account of the merchant. And of receiving

information from the merchant for crediting an account of the merchant.

However, in Abstract, col. 2, lines 35-67, col. 6, lines 15-55 thereof, Kight et al. disclose(s) the sum of a group of requests does not exceed the amount in the account otherwise the transaction would fail. It would be obvious to one of ordinary skill in the art to modify the invention of McCoy et al. and Ganesan et al. based on the teachings of Kight et al. The motivation to combine these references is to effectively and efficiently do a wire transaction.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCoy et al., Ganesan et al. and Kight et al. as applied to claim 17 above, and further in view of Deep.

Re claim 18: McCoy et al., Ganesan et al. and Kight et al. disclose(s) the claimed invention wherein wherein each of the plurality of credits is less than a plurality of debits from the bank account by a fee.

However, in col. 7, lines 60-65, claim 5, thereof Deep discloses reducing the credit by a fee. It would be obvious to one of ordinary skill in the art to modify the invention of McCoy et al., Ganesan et al. and Kight et al. based on the teachings of Deep. The motivation to combine these references is to effectively and efficiently move funds from point to point.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles

Examiner

Art Unit 3624

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read "Vincent Millin", written in a cursive style.